

56-59 as being dependent upon a rejected base claim, but allowable if rewritten in independent form; and allowed claims 13, 14, 25, and 36-44.

Applicant thanks the Examiner for the indication of allowable subject matter in claims 13, 14, 16, 17, 19, 20, 25, 36-44, 46-49, 51-54, and 56-59.

Applicant respectfully traverses the Examiner's rejection of claims under § 103(a) for the following reasons.

35 U.S.C. § 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claim invention were, at the time of the invention, was made, owned by the same person or subject to an obligation of assignment to the same person.

The Stephens patent issued on December 5, 2000, was filed on December 6, 1996, and claims benefit of an earlier divisional application filed December 31, 1994. Applicants filed the present application on May 25, 2000. Therefore, the Stephens patent can qualify as prior art, if at all, only under one or more of 35 U.S.C. § 102(e), (f), or (g), as required under § 103(c). As stated above, § 103(c) states that prior art under § 102(e) shall not preclude patentability of an invention if the invention was (1) developed by another person, and (2) commonly owned or subject to an obligation of assignment to the same person. The Stephen patent meets both of these requirements of § 103(c), because Makoto Yamamoto, the inventor of the present application, is not an inventor of the Stephens patent and is, therefore, "another person" or inventive entity in the eyes of the law.

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The assignment of the present application is to Kabushiki Kaishi Sega Enterprises, which is the same entity named as the assignee listed on the face of the Stephen's patent, i.e., Sega Enterprises, Ltd., as required for § 103(c).

The undersigned attorney therefore states on behalf of Applicants that the present application and the Stephens patent were, at the time the present invention was made, owned by, or subject to an obligation of assignment to, the same corporate entity, i.e., Kabushiki Kaishi Sega Enterprises.

Therefore, 35 U.S.C. 103(c) operates to remove the Stephens patent as prior art in the present application.

The Examiner rejected claims, 1, 15, 18, 45, 50 and 55 based on the combination of Miyamoto and Stephens. In explaining the rejection, the Examiner admits that Miyamoto at least does not disclose certain features and relies on Stephens for disclosure of such features missing from Miyamoto. With Stephens not available as prior art against the present application, the Examiner's rejection based on Miyamoto alone cannot stand, at least in view of the deficiencies in Miyamoto identified by the Examiner. Applicant therefore requests withdrawal of the rejections of claims 1, 15, 18, 45, 50 and 55 and their allowance.

In rejecting claims 2-11, 21-24, and 26-35, the Examiner again relies on the combination of Miyamoto and Stephens along with Kami. In view of Stephens not available as prior art, this rejection can not stand. Applicant therefore request withdrawal of the rejection of claims 2-11, 21-24, and 26-35, and their allowance.

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In responding to the Examiner's rejections under § 103(a), Applicant's remarks are not intended to indicate any particular agreement with the Examiner's characterization of Applicant's invention or the applied references.

In view of the above remarks, Applicant requests reconsideration and withdrawal of the rejections and the timely allowance of this patent application.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 27, 2003

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